

REMARKS

Claims 1-20 are currently pending in the application. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §102/103 Rejections

Claims 18-20 were rejected under 35 U.S.C. §102(a) for being anticipated by Forecast Pro Product Description. Claims 1-17 were rejected under 35 U.S.C. §103(a) over several references, at least one of which included the Forecast Pro Product Description. These rejections are respectfully traversed.

Disclosure Not Available to Public

In this office action, the Examiner relies on the Forecast Pro Product Description as prior art under 35 U.S.C. §§102(a) and 103(a). In these rejections, the Examiner is relying on the copyright date of the publication as of December 31, 2000, but still does not show a "posting date" of the publication.

As previously argued, it is critical and incumbent upon the Examiner to show the publicly available date of a reference to establish a rejection under 35 U.S.C. §§102(a) or 103(a). MPEP §2128 clearly sets forth in pertinent part:

Prior art disclosure on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)

Applicants submit that the Examiner has not shown the publicly available date, e.g., posting date, of Forecast Pro Product Description. This is very important in the rejection

under 35 U.S.C. §§102(a) or 103(a). Instead, the Examiner has merely shown a copyright date, which does not constitute a date of availability to the public. The copyright date, for example, may have been placed on the Forecast Pro Product Description well before the publication became accessible to the public, thus showing the date of the copyright is not a date of availability.

In support of Applicants' argument, an electronically available reference can be proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to ... persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981). However, a mere copyright notice does not meet this standard. As argued above, the copyright notice may have been placed on the document well prior to the first public dissemination of such document to the public. This is the exact reason that the showing of the date the item was publicly posted is so critical to a showing of public disclosure for purposes of prior art.

Applicants also direct the Examiner's attention to the Patent Office's own publication entitled "Prior Art in the Field of Business Method Patents - When is an Electronic Document a Printed Publication for Prior Art Purposes?", presented at AIPLA, Fall 2002, by Wynn W. Coggins, USPTO. (See, <http://www.uspto.gov/web/menu/pbmethod/aipfall02paper.htm>). Quoting this document, Mr. Coggins notes that

H. WEBSITES AS PRIOR ART

Websites can be used as references if posting dates can be found, and those posting dates predate the invention.

However, there simply is no mention that a copyright notice can be used to show the reference predates the invention. Instead, this publication specifically refers to "posting dates". In fact, an extensive search of this publication does not even reveal the use of copyright notice to evidence a public posting date.

By way of further illustration to show the import of evidence showing that a document must be publicly available, in *Carella v. Starlight Archery*¹, the court held that there was no evidence that a mailer was received by an addressee prior to a patent filing date. Plus, the court held that there was no proof that advertisement (in the Wisconsin Bow Hunter Association (WBHA)) was accessible to any member of the public before the filing date, thus negating the rejection under 35 U.S.C. 102(a). In both of these situations, it is very plausible, and most probable, that the mailer and the magazine had copyright notices, which predated the actual mailing of the mailers and magazines.² This is the exact reason of the importance to show the posting date (and not merely a copyright date) of an Internet posting, which would evidence the available date of the publication for reasons of §§102(a) or 103(a).

Other substantive Matters

On other substantive issues, Applicants further note that the printed publication of Forecast Pro Product Description is not enabling for purposes §§102(a) or 103(a). For example, MPEP §2121.01 states:

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Foundation for*

¹ 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986)

² See, also, *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956). (A publication disseminated by mail is not prior art until it is received by at least one member of the public. Thus, a magazine or technical journal is effective as of its date of publication (date when first person receives it) not the date it was mailed or sent to the publisher.)

Medical and Education Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)

Applicants submit that the Forecast Pro Product Description is not enabling and can only be used for what it shows. In the Forecast Pro Product Description, only a vague disclosure was provided, e.g.,

The built in expert selection system analyzes your data, selects the appropriate forecasting technique, builds the model and calculates the forecasts

(See page 1 of the disclosure)

It is apparent that this publication does not explain how these features are performed except, though, the use of many different forecast techniques such as, for example, curve fitting, low volume models, etc. As to the remaining features, this publication only concludes that these features are available, without a discussion on such implementation. It is thus submitted that one of ordinary skill in the art would not be able to make use of the expert system disclosed in the Forecast Pro Product Description, without undue experimentation.

With this said, MPEP §2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that

offsets year dates in only two-digit formats). See also MPEP §2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. §102 rejection. See MPEP § 2131.01.

Forecast Pro Product Description does not meet these standards. Forecast Pro Product Description does not show the identical invention in as complete detail as is contained in the claims. For example, Forecast Pro Product Description does not show the features of the claims, for which it is applied, e.g.,

... actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element; (claim 1)

Applicants further submit that the remaining references also do not show the features recited in the claimed invention.

Applicants submit that Kadowaki does not teach the features of the claimed invention, as argued by the Examiner. In Kadowaki, the apparatus, in contrast to the presently claimed invention, uses a key (user ID) corresponding to a user. This key, or user ID, identifies particular, user-specific, image forming information to be used in forming an image for the user. Consequently, the key is simply used to designate acquisition of pre-existing setup information corresponding to the key. As such, Kadowaki does not first select a personalization engine and then use that personalization engine to access a database to further select personalized information, as in the claimed invention.

Also, the arbiter of the presently claimed invention differs from the printer controller of Kadowaki. In the presently claimed invention, the arbiter actively selects a personalization engine according to various methods. The printer controller of Kadowaki does not perform such a feature. Instead, it simply routes the user ID provided by the print job to the network address of a particular personalization server that was contained in the user ID. But, in actively selecting a personalization engine, the arbiter of the presently claimed invention bases its analysis on information provided by the request object, a profile database, or a combination thereof. Based on this active analysis, the arbiter then chooses a personalization engine which is best adapted to making the best choice of which personalized content object to be retrieved from the content database. Once chosen, by the arbiter, the personalization engine performs a second selection process.

The user ID of Kadowaki, by contrast, contains a *pre-selected* network address of a particular personalization server. That the personalization server is uniquely and singularly pre-determined, without possibility of the printer controller actively selecting a different personalization server, is further exemplified by Kadowaki's teachings at Column 15, lines 41-44, that

a certain user acquires personalizing information from a personalizing server 3-1, and another user acquires personalizing information from a personalizing server 3-2.

In marked contrast to the arbiter of the claimed invention, the printer controller taught by Kadowaki performs a passive role rather than an active one, for it merely routes the user ID and other information to a personalization server 3-1, whose particular, pre-specified network address exactly matches the network address contained in the user ID. Thus, it cannot be considered or interpreted as being the same or similar to the arbiter claimed by Applicants; nor can it be considered or interpreted as performing the same or similar functions as the arbiter claimed by Applicants.

The Examiner is of the opinion, though, that the Kadowaki printer controller is an arbiter which directs personalization information to a personalization server. This is not accurate. As explained above, the printer controller of Kadowaki does not engage in a selection process. Rather, it simply sends apparatus ID information to a pre-specified personalization server. The apparatus ID contains a number that identifies a particular

type of printer to be used in the image formation process. Identifying a particular machine by ID information, however, simply relies on linking a particular machine to a particular ID number. This teaching is contrary to the present invention because it requires no analysis and selection based on at least one profile element as claimed.

Also, the printer and page-related attributes taught by Kadowaki at Column 19, lines 3-10, cannot be interpreted to anticipate Applicants' claimed profile elements; nor can the user ID be interpreted to anticipate Applicants' claimed request object, as suggested by the Examiner. Kadowaki teaches:

- 1) receiving a print job containing, *inter alia*, a user ID,
- 2) routing the user ID containing the network address of a particular personalization server to a printer controller,
- 3) routing the user ID, apparatus ID, and password to the specified personalization server,
- 4) retrieving personalization information containing printer and page-related attributes from the server, and
- 5) storing this personalization information in storage areas associated with the printer controller.

In Kadowaki, the attributes are not accessed until after the user ID is sent to the designated personalization server. Clearly, the attributes taught by Kadowaki are not associated with the print job before it is sent to the printer controller.

Kurtzman II discloses a user profile technique that builds a user profile based on the content of files selected and viewed by a user over the Internet. As described in

Kurtzman II at Column 2, lines 53-67 – Column 3, lines 1-67, a website server receives requests for advertisements and forwards these requests to an affinity server. The affinity server receives the requests and selects an advertisement from an ad database using one of several methods, including: sponsorship categories, ad inventory, and user profiling. When initiated by the affinity server, the user profiling module performs content stream analysis using demographic, geographic, psychographic, digital identification, and HTTP information. The affinity server then selects an advertisement, which is sent back to the web server, where it is associated with a new web page. Thereafter the new web page is sent to the user, who sees the advertisement displayed thereon. Clearly, as recited above, the teachings of Kurtzman II are not even remotely similar to the features of claim 1.

The combination of Kadowaki and Kurtzman II does not disclose each and every feature of the claimed invention. In fact, each of these references addresses different problems in very different fields. Because the applications of technology taught in each reference are so different, Applicants submit that there would be no reasonable expectation that an apparatus or method conceived by combining the teachings of all three references would operate at all. In other words there is no reasonable expectation of success. Furthermore, because the problems addressed by these references are so different, there would be no motivation for a person skilled in the art to combine the teachings of each reference. For example, a person skilled in the printer art attempting to solve problems therein would not be motivated to look to the content stream analysis

art (Kurtzmann II) for possible solutions. Clearly, the combination of references makes sense only after reading Applicants' specification, which is impermissible hindsight.

The Examiner's position with respect to claim 7 is as follows:

(a) Kadowaki does not teach the method wherein the plurality of personalization engines comprises at least two personalization engines selected from the group consisting of a rule-based personalization engine, a predictive-modeling personalization, and a collaborative filtering personalization.

(b) Jacobi, at Column 2, lines 18-21 allegedly teaches a collaborative filtering engine.

(c) Tetzlaff, at Column 2, lines 22-27 teaches a feedback generator, which the Examiner interprets as a personalization engine because it allegedly uses rule-based protocol to give feedback to a user depending on a particular user model.

Jacobi does generally disclose the use of collaborative filtering techniques. However, as Jacobi is directed to an electronic book recommendation service, it does not teach the arbiter or personalization engines as claimed by Applicants. Consequently, its combination with Kadowaki fails to cure Kadowaki's deficiencies.

Regarding (c), Applicants respectfully submit that the Examiner's interpretation of the feedback generator taught by Tetzlaff as the claimed personalization engine by Applicants does not appear to be correct. The feedback generator of Tetzlaff functions

as a comparator to indicate whether a user's nutrient values for elements of given meal are or are not appropriate. For these reasons, Applicants respectfully submit that the feedback generator taught by Tetzlaff cannot be interpreted as the personalization engine of the claimed invention. Consequently, its combination with Kadowaki and Jacobi fails to cure their deficiencies.

As discussed, the combination of Kadowaki, Jacobi, and Tetzlaff does not disclose each and every feature of the claimed invention. In fact, each of these references addresses different problems in very different fields. Because the applications of technology taught in each reference are so different, Applicants submit that there would be no reasonable expectation that an apparatus or method conceived by combining the teachings of all three references would operate at all. For example, it is difficult to imagine the printer controller of Kadowaki even functioning if programmed according to the food processor teachings of Tetzlaff or according to the book recommendation teachings of Jacobi. But even if such a device did function, it still would not disclose at least the arbiter as claimed.

Furthermore, because the problems addressed by reference are so different, there would be no motivation for a person skilled in the art to combine the teachings of each reference. For example, a person skilled in the printer art attempting to solve problems therein would not be motivated to look to the food processor art (Tetzlaff) or to an online book recommendation service (Jacobi) for possible solutions. Clearly, the combination of references makes sense only after reading Applicant's specification, which is impermissible hindsight.

Accordingly, Applicants respectfully request that the rejection over claims 1-20 be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a stylized, looping flourish at the end.

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